

Serial No. 10/659,735
Docket No. SHE0064.00

REMARKS

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I. The Restriction And Other Requirements:

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

I. Claims 1-18, drawn to a method for making an ortho ester (classified in class 525, subclass 61);

II. Claim 19-27, drawn to a method for making a carboxylic acid (classified in class 525, subclass 61);

III. Claims 28-57, drawn to a polymer of the structure in claim 28 (classified in class 525, subclass 78.17);

IV. Claims 58-83, drawn to a polymer of the structure in claim 58 (classified in class 525, subclass 78.17);

V. Claim 84, drawn to a carboxylic acid or carboxylic ester having the structure in claim 84 (classified in class 424, subclass 78.17).

The Examiner has indicated that claim 85 is common to Groups III and IV.

In addition, the Examiner has alleged that claims 1, 19, 28, 58 and 84 are generic to the following disclosed patentably distinct species:

- (a) a method for making an ortho ester-containing polymer;
- (b) a method for making a carboxylic acid-containing polymer;
- (c) a polymer of claim 28;
- (d) a polymer of claim 58; and
- (e) a polymer of claim 84.

In view thereof, the Examiner has required election of a single disclosed species.

Additionally, with respect to each of the Groups identified above, the Examiner has further required as indicated in the Office communication election of one specific disclosed polymer that is completely defined.

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II. Response to the Restriction Requirement:

In response, Applicant hereby makes the following elections:

Group III;

(c) a polymer of claim 28; and

with respect to the formula provided in claim 28, the specific polymer of

$$\text{H}_3\text{CO}-(\text{CH}_2\text{CH}_2\text{O})_m-\text{CH}_2-\text{CH}_2-\text{CH}_2-\text{C} \begin{array}{l} \nearrow \text{O}-\text{CH}_2 \\ \nearrow \text{O}-\text{CH}_2 \\ \nearrow \text{O}-\text{CH}_2 \end{array} \text{CH}_3$$
 (wherein with respect to the formula, "z" is three, "X" is absent since "a" is zero, R¹ is H, R² is H, "POLY" is (CH₂CH₂O)_m, and methoxy is the end-capping moiety).

The claims believed to be readable upon these elections are 28-30, 38-44, 46-49 and 52-54.

Each of the elections is made, *with traverse*.

Traverse of the restriction requirement is premised on the ground that a combined search of all five Groups does not impose an undue burden on the Examiner. As stated in the Manual of Patent Examining Procedure ("MPEP"),

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

See M.P.E.P. Section 803.

Here, all of the Groups except Group V have been assigned to the same initial classification (i.e., class 525), thereby suggesting that a search of potential art in this class is simultaneously useful for each of Groups I, II, III and IV. In addition, because some of the claims in Group V share some common claim features with one or more other Groups, a search of any other Group would be useful for Group V. In view of the above, it is therefore believed that search and examination of the entire application can be made without serious burden to the Examiner. Consequently, reconsideration and removal of the requirement for restriction are respectfully requested.

In addition, with respect to the requirements to elect specific species, Applicant emphasizes that the independent claim appears to be easily searched to thereby narrow the amount of relevant prior art the Examiner must consider. In this way, the Examiner should be

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able to identify any relevant prior art for the entire scope of the elected Group and not simply for the elected species.

Finally, Applicant emphasizes that election of the species is for initial search purposes only and that Applicants will be entitled to consideration of additional species upon the allowance of a generic claim as provided by 37 C.F.R. §1.41.

III. Conclusion:

In view of the foregoing, Applicant submits that the all of pending claims satisfy the requirements of patentability and are therefore in condition for allowance. Consequently, a prompt mailing of a Notice of Allowance is earnestly solicited.

If a telephone conference would expedite the prosecution of the subject application, the Examiner is requested to call the undersigned at (650) 620-5506.

Respectfully submitted,

Date: October 19, 2006

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